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# Supreme Court of the United States

OCTOBER TERM, 1941

No. 652

TERNSTEDT MANUFACTURING COMPANY
and GENERAL MOTORS CORPORATION
*Petitioners,*

*v.*

MOTOR PRODUCTS CORPORATION,
*Respondent.*

## RESPONDENT'S BRIEF ON PETITION FOR WRIT OF CERTIORARI

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I.

This is an ordinary patent case. Both the District Court (Eastern Dist. Mich. S. Div.)[1] and the Circuit Court of Appeals for the Sixth Circuit[2] held all of the claims in suit invalid for anticipation or lack of invention in the light of the prior art. The Bill of Complaint was dismissed on that ground.

[1]The District Court opinion will be found at 30 F. Supp. 288 and at Vol. I, page 748 of this record; the Findings of Fact and Conclusions of Law are at Vol. I, page 756.

[2]The opinion of the Circuit Court of Appeals will be found at 50 U. S. P. Q. 259 and has been included as an appendix to petitioners' brief.

There is nothing in the present petition which brings this case within any of the provisions of Rule 38, Sec. 5 of this Court relating to the granting of writ of certiorari. There is no conflict of opinion between Circuit Courts of Appeal, no unsettled legal propositions, and no question of general or public interest.

II.

The petition cites the case of the *Schrieber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47 as precedent for the granting of this petition but the situation in that case was exactly opposite to that which exists here. There certiorari was granted because the patents in suit (relating to automobile pistons) had been **sustained** and the patent owners could control the entire automotive industry **without moving from the Sixth Circuit**. Here the patents have been held to be invalid **and there is absolutely nothing to prevent petitioners from suing in any other circuit**. Automobile companies do business in every state of the union and large quantities of the ventilating windows here in suit are made by others than Respondent and used by various automobile companies. The alleged futility of petitioners filing suits in other jurisdictions is mythical (except for the likelihood of again being defeated). The situation here is no different from that which exists in any case of an unsuccessful plaintiff in a patent suit. If petitioners' position were sound, then this court should grant writ of certiorari in every case where a court of Appeals holds a patent invalid.

III.

The gist of petitioners' contention that the Court of Appeals misinterpreted R. S. 4886 and R. S. 4888 is that the prior art did not really disclose the invention of the Wright patent in suit. In finding that the prior art (in-

cluding the patents, publications and a prior use) did disclose the same inventive concept as Wright, neither the District Court nor the Circuit Court of Appeals announced any theory or statement of law which is contrary to that established by this court or which follows a new or uncharted channel. In substance, petitioners' contention is merely that both courts were incorrect in their findings. That petitioners are dissatisfied with the findings is no reason for the granting of writ or certiorari.

IV.

Petitioners having failed to show any reason, except dissatisfaction with the decision of the Circuit Court of Appeals, why their petition herein should be granted, a discussion of the merits of the case would appear unnecessary. The short statement and argument which follow are included solely for the purpose of making available to this Court a very brief explanation of some of the issues that were presented to and decided by the Court of Appeals.

## STATEMENT

From the time that closed automobile bodies were first built it has been the practice of automobile manufacturers to provide a vertically sliding window in the front door of the car. Raising of the window completes the enclosure while lowering of the window permits the ingress and egress of air to and from the interior. The only thing which the patentee Wright (II, 793, I, 26) did to this conventional construction was to insert in the window opening, forwardly of the vertically slidable window pane, a pivoted wing or panel secured to the front door pillar so it might pivot about its front edge. When this pivoted wing is swung outwardly about its front pivot, the rear edge is

moved away from the car body leaving an opening through which air may be **withdrawn** from the car body as a result of suction or ejector action induced by the forward movement of the car itself. Wright says in his specification (page 2, lines 32-35):

> "When the window 23 is in position A or any intermediate position, the motion of the vehicle induces air to flow *from* the interior of the vehicle outwardly * * *."

Wright's window 23, being pivoted at its forward edge, did not permit intake of air at the forward edge nor did it provide means for forcing air into the car.

Contrary to the impression left by the petition and accompanying brief, this structure **has not been adopted or used** by any American manufacturer of automobiles. The constructions involved in this suit and those used by other American automobile manufacturers are more of the type disclosed in the Fisher patent No. 2,048,605 (II, 805, I, 26) which provided means for forcing air into the car. This Fisher patent was also held to be invalid by the District Court and by the Circuit Court of Appeals but it is not urged in this petition. As petitioners no longer rely upon the Fisher patent we need not refer to the prior art invalidating it.

The original Wright patent played absolutely no part in the development of what petitioners choose to call "no draft ventilation." Wright was not even known to petitioners until the original Wright patent was issued, just prior to the commercial production by petitioners of the construction shown in the Fisher patent. They elected to purchase the Wright patent for a nominal amount and to reissue it in an endeavor to secure broad claims with which they might blanket and dominate the art. The original patent as issued did not contain claims broad

enough to do this, although Mr. Wright had unsuccessfully attempted to secure such broad claims during the prosecution of his patent application. The broader claims which were obtained by the reissue (not limited to pivoting the panel along its front edge or to the door front pillar) are invalid because they are not different from similar claims which Mr. Wright had endeavored to obtain but had cancelled from his application after rejection by the Patent Office. (*Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., et al*, 294 U. S. 477, 492.) The District Court and the Court of Appeals apparently found it unnecessary to hold the claims invalid for this reason because they found the claims to be clearly anticipated and invalid over the prior art.

Petitioners' many statements regarding the commercial success of Wright and what they consider to be favorable remarks of the court regarding "the ventilating arrangement involved in this case" do not apply to the disclosures of the Wright patent for the very simple reason that **the Wright structure has never been used** in this country. Neither of the courts below found that the Wright structure had been used by any American manufacturer, although the District Court found that certain of the broad claims of the Wright reissue patent would read on respondent's devices, if the claims were valid. Petitioners ingeniously intertwine the Fisher patent, the Wright patent and so-called "no draft ventilation" to have it appear that all statements made by them and the courts below apply specifically to the Wright patent, but such is not the case. It is only by the provision of means for **directly inducing air into** the car body, through a pivoted window, that any commercially desirable system is provided. As stated above, Wright is completely deficient in this respect.

The use of a pivoted window construction as a means of ventilating a car followed a conventional and routine pattern. It was first proposed for railroad cars, then for open automobiles and then for closed automobiles. In closed automobiles it was first built in custom or tailored installations and as an accessory. Finally it was built in as standard equipment by one large manufacturer so that its customers no longer had to buy it as an accessory. Other manufacturers also provided it as standard equipment, in order that their customers would not have to pay the accessory price. In making the standard equipment installations, the manufacturers simply assembled these early devices bodily into the cars as built and delivered from the factory. This was the same pattern as had been followed in adopting as standard equipment such items as windshields, speedometers, shock absorbers, radiator shutters, bumpers, water temperature indicators, etc. (I, 347, 348).

## ARGUMENT

Both the District Court and the Court of Appeals found the broad claims of the Wright reissue patent to be anticipated and invalid over various prior art structures, many of which included the feature in which Wright was deficient—the arrangement of the wind wing so as to force or blow air into the car body. This prior art included, among others, United States patent to Fennerty No. 333,620, the article entitled "Development of the California Top" in the publication AUTOBODY of February 1922, and the R & V Knight car as used by Stafford. A series of prior art disclosures appears in the record Vol. II, pages 1509 to 1609.

## FENNERTY PATENT NO. 333,620

The Fennerty patent (II, 1521, I, 266) disclosed a Pullman car having conventional sliding windows, each sliding window having a pivoted window or wing on each side thereof. A Pullman car, of course, might be run in either direction, and the provision of a pivoted window on each side of the sliding window made it possible for the pivoted window which happened to be on the front side of the sliding window to be opened to give the desired ventilation or extraction of air from the car body. Fennerty describes exactly the same function and operation as is described in the Wright patent. Wright's specification states as his object "to ventilate thoroughly and well the interior of the vehicle without producing violent drafts" and says that "this is accomplished by" providing the pivoted panel which, when in open position, enables the motion of the vehicle to "induce air to flow **from** the interior of the vehicle outwardly." Fennerty's specification states that he obtains "perfect" and "complete" ventilation by the use of his pivoted panel which, when in open position functions so that "the foul air of the car is **drawn out**, on the ordinary ejector principle." Wright says his pivoted panel, when functioning to ventilate, excludes "the entry of rain or snow to the interior of the vehicle," while in Fennerty his panel functions to ventilate with the "complete exclusion of dirt, dust, etc." The District Court said (I, 751),

> "I think Fennerty and Wright are about as near alike as two peas in a pod."

That the disclosure of Fennerty is full and complete was admitted by petitioners' expert witness (I, 655),

> "Q. Well, Wright doesn't teach you anything more about the operation of the structure which he

discloses, namely a swinging panel in front of a vertically sliding panel than Fennerty does, does he?

"A. I believe that is a fair statement."

Petitioners' counsel attempted to differentiate Wright over Fennerty because Fennerty showed his ventilating system in a Pullman car instead of in the door of a motor car, but that contention is contrary to the statement in petitioners' Fisher patent (II, 805) that these ventilating systems are applicable to moving vehicles including not only automobiles but "**railway cars**, boats, airplanes and other vehicles." That it makes no difference whether the ventilating window is provided in the door or in the side of the car is borne out by the testimony of petitioners' own expert witness (I, 99, 100) that:

> "Obviously when the door is closed the panels do not know whether they are attached to the door or to the body. * * * If we wanted to weld up the door (of the Wright structure, for example) into the side of the body, the ventilation operation would be the same."

The District Court summed up the situation when it said (I, 752):

> "I place no importance on the fact that Fennerty applied the construction to a closed railroad car body rather than to a closed automobile body. They are both closed vehicle bodies which move at relatively high speed, and *the problem of letting air in and out without subjecting the passengers to undesired drafts is the same in both,*"

and when it made the finding of fact (I, 764):

> "19. The ventilating window arrangement of the Fennerty Patent No. 333,620, January 5, 1886, is identical in all material respects relating to both structure and operation with the ventilating window arrangement described and claimed in the Wright reissue patent."

Fennerty is a complete anticipation of the broad claims of the Wright reissue patent and contains a complete description of the function and mode of operation thereof.

## THE PUBLICATION "AUTOBODY" OF FEBRUARY 1922

This publication (II, 1543, I, 266) disclosed a pivoted panel or wing A, exactly the same as that of Wright and shows it applied to an automobile body. The only distinction between this disclosure and the Wright disclosure is that Wright showed his pivoted panel or wing applied to a conventional closed automobile body having vertically slidable main windows while the publication showed the pivoted panel or wing in conjunction with a fore and aft slidable window such as was conventionally used with so-called "California tops" which were designed to make closed cars of what had originally been open cars. There is no difference whatever in the functioning of the pivoted panel, whether it is used with a window which slides fore and aft or up and down. California tops, being built for installation on open cars, could not have their windows slide up and down because no provision had been made in the cars as originally built to receive the window if it were lowered. Nothing could be more obvious to the original builder of a motor car, if he wanted to use the pivoted window of this publication in a closed car, than that he should use the conventional vertically sliding window which he had always used when building a closed car.

Referring to the disclosure of this publication, the District Court formally found (I, 765):

> "The front window of this car is divided into two panels—a rear panel which is slidable and a forward panel which is hinged at its front edge to provide an adjustable wind deflector. This construction is identical in all material respects, relating to both structure and operation, with the ventilating

window arrangement described and claimed in the Wright reissue patent. The fact that the rear panel of the California top construction opens by sliding horizontally instead of sliding vertically, as in the Wright patent, is of no significance either as a matter of structure or as a matter of result."

Every function and purpose of the Wright patent is disclosed in this publication.

## THE R & V KNIGHT CAR AS EQUIPPED AND USED BY STAFFORD

Long prior to the Wright patent, Elmore H. Stafford, a lawyer of Rock Island, Illinois, purchased an R & V Knight open touring car which had as **standard equipment** a pivoted window positioned immediately back of the windshield. This window had its pivot so arranged that the window could not only be swung to **extract** air from the car but could also induce air to flow **into** the car, and Mr. Stafford testified (I, 314-316) that he had used the window throughout his ownership of the car for both purposes.

The actual car owned by Mr. Stafford was produced and was available at the taking of his testimony and at the trial. Photographs of the same were introduced in evidence (II, 1605-1609, I, 314-316). These photographs show the so-called "California top" enclosure windows which were installed in this car by Mr. Stafford in order to make it into a closed car. The proofs of the purchase of the car and the installation of the California top or sliding windows were clearly corroborated by documentary evidence so that the facts of its existence, use and operation were accepted as clearly established by both of the courts below.

As we have already indicated, this construction not only anticipates and invalidates the broad claims of the Wright reissue patent, but, in fact, constitutes a system much better than Wright and more nearly like that employed by respondent.

## OTHER PRIOR ART

There were various other prior art references referred to by the courts below, including wind wings of various kinds used as accessories before the automobile companies decided to incorporate them as standard equipment. It seems unnecessary, however, to prolong this brief by reference to them.

## CONCLUSION

It will be seen from the foregoing that the many decisions referred to in petitioners' brief have no application here for the simple reason that the decisions of the courts below are not in conflict with them. As a matter of fact, the law announced in those decisions was followed and applied in holding the broad claims of the Wright reissue patent invalid. **Petitioners have not pointed out a single statement in the opinion of the Court of Appeals which is in conflict with the decisions referred to by petitioners.**

The petition for a writ of certiorari should be denied.

Respectfully submitted,

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